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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,796	09/28/2001	Maximilian Angel	0050/51796	2868

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KEIL & WEINKAUF
1350 CONNECTICUT AVENUE, N.W.
WASHINGTON, DC 20036

EXAMINER

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 12/19/2002

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant(s)

09/964,796

Applicant(s)

ANGEL ET AL.

Examiner

Judy M. Reddick

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09/28/01;01/09/02;04/08/02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 & 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 1713

DETAILED ACTION

Pri rity

1. **Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.**

Information Disclosure Statement

2. **The information disclosure statements filed 01/09/02 & 04/08/02 have been considered and placed in the application file.**

Claim Rejections - 35 USC § 112

3. **The following is a quotation of the second paragraph of 35 U.S.C. 112:**

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

A) The recited "obtainable by" per claim 1 constitutes indefinite subject matter as per it not being apparent if or how said objectionable phrase further limits the claims.

B) The recited "one or more compounds of the formula (A) or (B)----- or mixtures thereof" per claim 1 constitutes indefinite subject matter as per there being no structural formula representative of (A) and (B).

C) The recited "where appropriate", all occurrences, per claim 1 constitutes indefinite subject matter as per it not being readily ascertainable as to if or how said objectionable phrase further limits the claims.

D) The recited "wherein the compounds of formula (A) per claim 4 and "wherein the compounds of formula (B) per claim 5 constitutes indefinite subject matter as per the non-express establishment of proper antecedent basis.

5. **Claim 9 provides for the use of water-s luble or water-dispersible copolymers, but, since the claim does not set f rth any steps involved in the method/process, it is unclear what**

Art Unit: 1713

method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 9 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example Ex parte Dunki, 153 USPQ 678 (Bd.App. 1967) and Clinical Products, Ltd. v. Brenner, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

6. *The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:*

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. *The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:*

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. *Claims 1-9 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Armour(U.S. 3,433,701) or Bergmeister et al(U.S. 3,817,896).*

Armour discloses and exemplifies adhesive compositions comprising stabilized vinyl acetate copolymer emulsions produced basically via emulsion polymerizing vinyl acetate and, as a comonomer, a hydroxyalkyl ester in the presence of about 2 to 12 wt.% of

Art Unit: 1713

polyvinyl alcohol wherein the ratio of vinyl acetate:hydroxyalkyl ester is 80:20(see the Abstract, cols. 3-4, Runs I and II and the claims of Armour).

Bergmeister et al disclose stable, aqueous copolymer dispersions of ethylene and vinyl acetate, useful in forming adhesives, paint binders, etc., prepared via aqueous emulsion polymerization in the presence of a redox catalyst, protective colloids and/or emulsifiers wherein up to 40 wt.% of the vinyl ester can be replaced with hydroxyalkyl esters and wherein the protective colloid includes polyvinyl alcohol(see, e.g., the Abstract and cols. 5-6 of Bergmeister et al).

Each of Armour and Bergmeister et al therefore anticipate the instantly claimed invention with the understanding that the components per each of Armour and Bergmeister et al overlap in scope with the components of the instantly claimed invention, in both content and character. Further, the use of the compositions of Armour and Bergmeister in the coating of a pharmaceutical dosage form is tenable since the composition of each of Armour and Bergmeister et al is essentially the same as and made under essentially the same conditions as the claimed copolymer.

As to the dependent claims, the limitations are either taught by Armour and Bergmeister et al, suggested by Armour and Bergmeister et al or would have been obvious to the skilled artisan and with a reasonable expectation of success.

Conclusion

9. *The additional prior art listed on the attached FORM PTO 892 is cited as of being illustrative of the general state of the art.*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the

Application/Control Number: 09/964,796

Page 5

Art Unit: 1713

*organization where this applicati n or proceeding is assigned are (703)872-9310 for regular
communicati ns and (703)892-9311 for After Final communications.*

*Any inquiry of a general nature or relating to the status of this application or proceeding
should be directed to the receptionist whose telephone number is (703)305-8183.*

J. M. Reddick
Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR *JMR*
December 16, 2002